



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|--|---------------------|------------------|
| 09/887,022 | 06/25/2001 | Valere Leopold, Marie, Pierre De Coninck | 7393/71576 | 6643 |

22242 7590 09/16/2003

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

BHAT, NINA NMN

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1761

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,022

Applicant(s)

DE CONINCK, VALERE
LEOPOLD, MARIE, PIER

Examiner

N. Bhat

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6/01. 6) ☐ Other: _____

DETAILED ACTION

1. The abstract of the disclosure is objected to because applicant has used the recitation "This invention relates to..." which should not be used in the abstract. The abstract should be concise statement of what is being claimed in the application. Applicant is reminded that the abstract should be in single paragraph no more than 150 words. Applicant can obviate this objection by deleting "The present invention relates to" and insert --An agglomerated starch base product and dry mixes is provided wherein-- Correction is required. See MPEP § 608.01(b).

2. Claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 2-7 applicant has used "characterized in that" language, which should be avoided when drafting claims as the characteristics of the invention is not a positive statement, applicant is suggested to delete "characterized in that" and insert --wherein--. In claims 2-3, 5 and 7A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd.

Art Unit: 1761

App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, in claim 2, the viscosity in cold milk is developed in less than 10 minutes, which is the broad recitation, and the claim also recites preferably less than 8 minutes, more preferably less than 5 minutes, which is the narrower statement of the range/limitation. Applicant should not use linking terms like "preferably" and recite the preferred times of 5 minutes and 8 minutes in separate dependent claims which depend from claim 2. Similarly, applicant has used the linking term "preferably" linking a broad range with a narrower range and in the other claims recited above and dependent claims should be made from those base claims mentioned above. Appropriate correction is required.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meister [USP 6,217,931] in combination with Dudacek et al. [USP 6,001,408].

Art Unit: 1761

Meister '931 teaches the invention substantially as claimed. Specifically, an improved thickened instant coffee beverage containing a mix from about 15-90% maltodextrin and an agglomerated starch which is admixed with mono and diglycerides with coffee flavorants has been described which can be quickly dissolved in water of at least 120°F without delay and without forming clumps. The agglomerated starch is a mixture of starch and maltodextrin with a thin layer of mono and diglycerides. Meister teaches that the agglomerated starch used in the process have good overall thickening qualities and are free flowing having an average particle size greater than 100 microns and the bulk density should be in the range of 5-25 lbs/ft³. The type of maltodextrin used has a bulk density of less than 30 lbs/ft³ and should be a granular form as opposed to a fine powder. The final viscosity of the thickened hot coffee beverage determines the range or amount of maltodextrin to be used. [Note Column 3, lines 39-66 and Column 4, lines 1-63]

However, Meister teaches that the agglomerated starch disperses instantly and simultaneously develops its full viscosity in a heated water containing liquid medium of 120°F which is not a cold water containing liquid medium as claimed.

Dudacek et al. teaches agglomerated starch products, which have hot and cold, water dispersibility and hot and cold swelling viscosity. The agglomerated starch is a mixture of starch and maltodextrin. Dudacek et al. teaches in Example 5, Column 14, lines 34 et seq, that a method is developed to prepare a composition useful in instantized application which makes agglomerated compositions of physically modified starch which has hot or cold liquid dispersibility by introducing into an extruder starting materials of a starch or mixture of starch and gum and starch and surfactant or starch, gum wherein a sufficient amount of water is added

Art Unit: 1761

to raise the total moisture into a moisture content from about 18% to about 45% by weight and extruding the starting material and water at die plate temperature from about 140°F to about 285°F and a pressure from about 200 to 2500 psig forming a substance comprised of gelatinized, partially gelatinized and ungelatinized starch granules. From the extruder the starch is ground into a desired particle size. [Note Column 3, lines 26-45] Dudacek et al. teach that modified starches can be dried, ground or milled provided that the conditions of drying, grinding or milling are selected so as to avoid further gelatinization and loss of functionality of the product. Dudacek et al. teaches that a cold or hot dispersability modified starch is dependent upon the moisture content of the starch and maltodextrin or composition.

It would have been obvious from the combined teachings of Meiser and Dudacek et al. to provide a cold water dispersible agglomerated starch based product consisting of starch and maltodextrin wherein the particle size is greater than 100 microns because Meiser teaches providing an agglomerate starch and starched based product which includes starch and maltodextrin wherein the particle size is greater than 100 microns, admittedly the agglomerated starch/maltodextrin is used in a thickened coffee beverage which uses hot water or water of at least 120°F which disperses immediately and provides a thickened beverage. However, Dudacek teaches making an agglomerated starch and maltodextrin composition wherein both hot and cold water dispersibility is achieved which is based on the moisture content as well as gelatinization temperatures when extruding the composition. After extrusion Dudacek teaches the agglomerated starch and maltodextrin can be ground, milled and/or dried and temperatures above 120°F should be avoided so that any further gelatinization can be minimized, to provide a cold water dispersible starch/maltodextrin agglomerated starch having a particle size such that at least

Art Unit: 1761

80% of the discrete particles are greater than 100 microns would have been obvious from the combined teachings because Meiser teaches the advantages of providing an agglomerated starch of greater than 100 microns and Dudacek teaches a process which provides either hot or cold water dispersible agglomerate starches which can be ground or milled to a desired size based on the application thus rendering applicant's invention as a whole obvious to one having ordinary skill in the art at the time of invention was made.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Meister et al. teach a composition and process for producing thickened coffee, tea or coca beverages. Dudacek et al.'623 and '756 teach starch producing having hot or cold-water dispersibility and hot or cold swelling viscosity. Tauson, Jr. et al. teach microcrystalline cellulose based stabilizer systems for suspending coca solids in dry mix instant chocolate drink formulations that are reconstituted with hot water. Cha et al. teach sugar-free, fat -free instant pudding mixes which contains 50-70% agglomerated pregelatinized starch, 5-23% maltodextrin, and 0-.1% to 1.5% xanthan gum, phosphate setting salt and slow reacting calcium salt, sweetener, opacifier, emulsifier flavor and color.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. Bhat whose telephone number is 703-308-3879. The examiner can normally be reached on Monday-Fridays from 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.


Application/Control Number: 09/887,022

Page 7

Art Unit: 1761

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.

September 8, 2003


NINA BHAT
PRIMARY EXAMINER
GROUP 1900, 1700